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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,810	05/31/2000	Dimitri Kanevsky	13539(YOR9-2000-0196US1)	2276
7590 12/02/2005			EXAMINER	
Richard L Catania Esq. Scully Scott Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			BOUTAH, ALINA A	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/584,810

Applicant(s)

KANEVSKY ET AL.

Examiner

Alina N Boutah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/30/05.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

This action in response to Applicant's amendment received September 12, 2005. Claims 20-21 have been newly added. Claims 1-5 and 7-21 are pending in the present application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to discuss: the user entering into the first database information identifying: (iv) compressed text that needs to be converted into post script format; and step (v) checking the license agreement to determine if compilation of the given program into a second source code is allowable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 8, 9, 11-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Probert in further view of CERN Conversion Service.

(Amended) Regarding claim 1, Shaffer et al. teach a method for re-formatting computer files, comprising the steps:

inputting a data file into a computer (Abstract);

using said computer to determine if the data file is compatible with the computer or applications which exist on the computer (Abstract; col. 2, lines 31-34);

if the data file is not compatible with the computer, transmitting the data file over the Internet from said computer to a universal server (Abstract; col. 3, lines 4-6, lines 21-37); and

the universal server, transforming the data file into a format compatible with the computer, and sending the transformed data file back to the computer (figure 1; col. 3, lines 21-37; col. 5, lines 22-42).

However, Shaffer fails to teach inputting a data file into a computer having a specified operating system; using said computer to determine if the data file is compatible with the specified operating system; said computer transmitting the data file over the internet from said computer to a universal server; and the universal server transforming the data file into a format compatible with the specified operating system of the computer.

Probert teaches inputting a data file into a computer having a specified operating system; using said computer to determine if the data file is compatible with the specified operating system; and the universal server transforming the data file into a format compatible with the

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specified operating system of the computer. (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50).

CERN teaches allowing user to upload files over the internet from a user's station to be converted (CERN: Mission statement).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. and CERN into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

(Amended) Regarding claim 2, Shaffer et al. teach a method according to Claim 1, wherein the transforming step includes the steps of, the universal server reading information from said computer; and on the basis of said information, identifying the type of file, and transforming the file into a different format of the same type (col. 1, line 55 – col. 2, line 3).

Regarding claim 3, Shaffer et al. fails to teach a method according to claim 1, further comprising the steps of: a user of the computer identifying user requirements; and transmitting the user requirements to the universal server; and wherein the transforming step includes the step of re-formatting the file in accordance with the user requirements.

CERN teaches a method for re-formatting a computer file comprising steps of: a user of the computer identifying user requirements; and transmitting the user requirements to the universal server; and wherein the transforming step includes the step of re-formatting the file in

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accordance with the user requirements (CERN User Guide, page 1-4). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of CERN into the teaching of Shaffer et al. allow the file conversion to be performed according to the user's need.

Regarding claim 4, Shaffer et al. teach a method according to claim 1, wherein, when data needs to be converted, the data are sent to a universal conversion server; the universal conversion server finds that the service cannot convert a certain file, the service looks in a computer description; the computer description can be located on the computer or on a universal conversion server database (col. 3, lines 1-13).

Regarding claim 5, Shaffer et al. fail to teach a method according to claim 1, wherein the data file is a computer program, and the transforming step includes the step of the universal server looking over the program to identify components of the program including links to the program source code, the program's executable code, the program's file name; entering data to a database of source codes, where many source codes are held; and if the same name exists among more than one program in the database, the Universal Server reads the information from the description module (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

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(Amended) Regarding claim 7, Probert Jr. et al. teach a universal program conversion method, comprising the steps of:

entering data into a computer (col. 1, line 60 – col. 2, line 19);

said computer having a specified operating system and checking to determine whether the format is compatible with an operating system (OS) in the computer (col. 1, line 60 to col. 2, line 19; col. 3, line 13 to col. 4, line 57);

if the format is not compatible, sending the data from the computer over a network to a remote Universal Driver (col. 3, line 13 to col. 4, line 57);

on the Universal Driver, reformatting the data into a format compatible to the OS (col. 3, line 13 to col. 4, line 57);

if it is determined that the data are compatible with the operating system, then checking to determine whether it is necessary to reformat the data (col. 3, line 13 to col. 4, line 57);

if the data do not need to be reformatted, processing the data as the user requests; and

otherwise, sending the data to the universal server; and this server checking whether the data are executables; if the data are executables, then checking the Universal Driver to determine whether the data can be formatted on the Universal Driver; if the data can be so formatted, then formatting the data at the Universal Driver; and then sending the formatted data to the user; if the data can not be formatted at the Universal Driver, then checking to determine if the source code exists on a storage of source code; if the source code exists, the universal driver then recompiling the data in a new OS, and the Universal driver then sending the data to the user; checking for instructions to format data; after the checking step, formatting the data are formatted according

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to the instructions, and then sending the data to the user (Abstract; col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50).

However, Probert, Jr. et al. fail to teach said computer sending the data from the computer over a network to a remote universal driver; and sending the data to a universal formatting server after the reformatting step to be converted to the format suitable for the user. CERN teaches allowing a user to send data from the user's computer to a universal formatting server for converting data suitable for the user (CERN User Guide, page 1-4). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of CERN into the teaching of Probert et al. in order allow the file conversion to be performed according to the user's need.

Regarding claim 8, this is similar to claim 1 therefore is rejected under the same rationale as specified above.

Regarding claim 9, this is similar to claim 2 therefore is rejected under the same rationale as specified above.

Regarding claim 10, this is similar to claim 3 therefore is rejected under the same rationale as specified above.

Regarding claim 11, this is similar to claim 4 therefore is rejected under the same rationale as specified above.



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Regarding claim 12, this is similar to claim 1 therefore is rejected under the same rationale as specified above.

Regarding claim 13, this is similar to claim 2 therefore is rejected under the same rationale as specified above.

Regarding claim 14, this is similar to claim 3 therefore is rejected under the same rationale as specified above.

Regarding claim 15, this is similar to claim 4 therefore is rejected under the same rationale as specified above.

Regarding claim 16, this is similar to claim 5 therefore is rejected under the same rationale as specified above.

Regarding claim 17, Shaffer et al. teach a method according to claim 1, further comprising the step of providing the Universal Server with access to a module having a series of source codes, and wherein the step of formatting the data file into a format compatible with the operating system of the computer modules the steps of:

the Universal Server obtaining from said module the source code for the data file (figure 1; col. 3, lines 21-37; col. 5, lines 22-42).

However, Shaffer does not teach the Universal Server recompiling the data file, using the source code obtained from said module, into the format compatible with the operating system of the computer. Probert teaches these limitations in (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

Regarding claim 18, Shaffer fails to explicitly teach a method according to Claim 17, wherein the step of the Universal Server recompiling the data file includes the steps of the Universal Server using the source code obtained from said module to modify the source code of the data file and using a compiler to compile a new data file, compatible with computer, from the modified source code of the data file. Probert teaches using the source code obtained from said module to modify the source code of the data file (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50); and using a compiler to compile a new data file, compatible with computer, from the modified source code of the data file (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

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Regarding claim 19, Shaffer fails to teach a method according to Claim 18, further comprising the step of the Universal Server reading from the computer the type of operating system on the computer. Probert teaches a universal server reading from the computer the type of operating system on the computer (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

### ***Response to Arguments***

Applicant's arguments have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of CERN.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ALINA N. BOUTAH  
Examiner